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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/767,169	01/22/2001	Mehmed K. Younouzov	2765	2576

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EXAMINER

HEWITT II, CALVIN L

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 05/11/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/767,169

Applicant(s)

YOUNOUZOV, MEHMED K.

Examiner

Calvin L Hewitt II

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 March 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3 and 12-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3, and 12-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Status of Claims

1. Claims 1, 3, and 12-21 have been examined.

Response to Amendments/Arguments

2. Regarding “storing at a website”, one of ordinary skill knows that user transaction data, such as names, addresses and credit card numbers are not stored on a website. To the contrary, a website is merely a GUI or interface which allows a user to interact with a database or server (Specification, page 3, lines 1-7, page 8, lines 9-23). The data is stored in a database, which can also be a server (see Microsoft Press Computer Dictionary Third Edition, page 430, “server”). When databases or file servers are created they are blank. Therefore, whatever data they store has to be entered at some point. Hence, as Boies et al. explicitly recite ordering goods and services (providing an address) over the internet (column/line 1/65-2/4; column 2, lines 30-35) and electronic marketplaces (column 2, lines 65-67), it would have been at least obvious to one of ordinary skill to allow a user to interact with the Boies et al. “registry” over the internet and provide the user’s name and address via input method prescribed by

Boies et al. (column 2, lines 1-5) which clearly suggests data being inputted via an internet interface (e.g. website).

Regarding claim 12, the Applicant is of the opinion that the prior art fails to teach a user being provided with shipping labels in order to send a package or letter. The Examiner respectfully disagrees. The Applicant in the analysis of claim 12 clearly envisions the "user" as the entity whose name is "real name" and lives at "real address". However, a careful examination of the claims fails to support such an assertion. Note, the claim does not recite "*user* real name" or "*user* virtual name". Similarly, the "displaying a webpage" step is also disjoint from the rest of the claim, as the claim is silent as to who establishes the virtual name and address. The virtual identity is established on a "first webpage" which is distinct from the "a webpage". Therefore, to one of ordinary skill in view of the prior art of Boies et al., the "user" can be the vendor. Also note, the limitation of "a server hosting a first webpage" is broad enough to read on the inherent presence of an ISP server. Overall, the first limitation has no effect, and is not related to the rest of the claim. This can also be seen by the fact that the first limitation refers to a "webpage" while the rest of the claim refers to a "website". Thus, the old and well-known process of a user at a vendor company surfing the web sufficiently teaches the first limitation of claim 12. It has been held that in order to be given weight in a method claim, the recited structure must affect the method in a

manipulative sense (Ex parte Pfeiffer, 1962 C.D. 408 (1961)). As this is not the case, the webpage, first webpage, and server of claim 12 is not afforded patentable weight. Boies et al. teach a vendor printer providing a label with the virtual name and address code (recall the “address code” of Boies et al. maps back to a real name and address) to a vendor and this label being provided to the shipping company (figure 2C). Figure 2C also reads on the “applying and shipping” step of claim 13. In general, the Applicants arguments concerning claims 12-17, consistently refers to the benefits of “e-box accounts” and “e-box indicias”. However, the claims are silent regarding these features, and although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims (*In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993)).

Regarding claims 1, 3, and 12-17 the Applicant merely canceled claims and moved subject matter from these claims and/or other claims into claims 1, 12 and 13. Therefore, the Examiner has re-arranged the rejection to claims 1, 3, 12 and 14-17 to adjust to the new claim arrangement.

Newly added claims 18-22 are also rejected.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 18-21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
5. Claims 18-21 recite a website that stores various data such as name, address, credit card data. However, this data is not stored on the website. To the contrary this data is stored on database or server.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1, 3, 18 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Boies et al., U.S. Patent No. 6,006,200 in view of Walker et al., U.S. Patent No. 6,163,771.

As per claims 1 and 3, Boies et al. teach a system for distributing goods from a website comprising: connecting a computer to an ISP, running a browser on said computer, storing a user's real name and address on a remote computer, storing a virtual name and address at said remote computer linked to the real name and address, accessing a second website, presenting an item by and selecting an item for purchase from an online service provider and utilizing said virtual name and address for shipping information (abstract; figures 1 and 2A; column 2, lines 1-10). Boies et al. teach online transactions (abstract) and a user ordering goods online (figure 2A). Hence, it is at least obvious that he contacting of the Registry is also done online (Figure 2A, items 203 and 204; column 2, lines 1-10). Boies et al. also teach sending the item to said virtual address, receiving said item at a location corresponding to said virtual address, re-labeling the item and sending the item to the user's real name and address. Regarding "re-labeling" it is at least obvious that this occurs in order to conform with USPS mailing rules and regulations. Boies et al. also teach a shipper having access to a third website, connecting to said third website and shipping labels (figure 2C; column 1, lines 23-35; column 2, lines 1-46). What is printed on the label is non-functional descriptive material. Boies et al. teach a method and system for providing a virtual name and address to a user for use in making purchases over the internet (abstract). However, Boies et al. do not explicitly recite virtual credit card numbers. Walker et al. teach a method and system for protecting user credit

card information by generating virtual credit card numbers (abstract) where the virtual card numbers are associated with a user's real card numbers (figure 13; column/line 11/62-12/18). Therefore, it would have been obvious to one of ordinary skill to combine the teachings of Boies et al. and Walker et al. in order to protect user financial data, such as credit card data ('771, column/line 2/7-3/5).

As per claim 18, the step of creating an "e-box" is equivalent to creating a user record in the Registry (column 2, lines 11-54).

As per claim 21, the step of creating an "e-box" is equivalent to creating a user record in the Registry (column 2, lines 11-54). Regarding a procedure for allowing a shipper to access a real name and address from a virtual one (column 2, lines 55-65), an internet or intranet website is a well-known method and system for accessing real-time data from a remote location.

8. Claims 12 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Boies et al., U.S. Patent No. 6,006,200.

As per claim 12, Boies et al. teach a system for distributing goods from a website comprising: connecting a computer to an ISP, running a browser on said computer, storing a user's real name and address on a remote computer, storing a virtual name and address at said remote computer linked to the real name and address, accessing a second website, presenting an item by and selecting an item for purchase from an online service provider and utilizing said virtual name

and address for shipping information (abstract; figures 1 and 2A; column 2, lines 1-10). Boies et al. teach online transactions (abstract) and a user ordering goods online (figure 2A). Hence, it is at least obvious that the contacting of the Registry is also done online (Figure 2A, items 203 and 204; column 2, lines 1-10). Boies et al. also teach sending the item to said virtual address, receiving said item at a location corresponding to said virtual address, re-labeling the item and sending the item to the user's real name and address. Regarding "re-labeling" it is at least obvious that this occurs in order to conform with USPS mailing rules and regulations. Boies et al. also teach a shipper having access to a third website, connecting to said third website and shipping labels (figure 2C; column 1, lines 23-35; column 2, lines 1-46). What is printed on the label is non-functional descriptive material.

As per claim 19, the step of creating an "e-box" is equivalent to creating a user record in the Registry (column 2, lines 11-54). Further, as the claim fails to define a "real name" as a "user's real name" and "real address" as a "user's real address", the term "user" is broad enough to read on the vendor of the Boies et al. system. Therefore, the first limitation of claim 19 is disjoint from the rest of the claim and is broad enough to read on an employee at the vendor company visiting the website of the shipping company.

9. Claims 13-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Boies et al., U.S. Patent No. 6,006,200 as applied to claims 1-3 and in further view of Rhoads, U.S. Patent No. 6,311,214.

As per claims 13-17, Boies et al. teach a method and system for providing a virtual name and address to a user for use in making purchases over the internet (abstract; figure 2A; column 2, lines 1-10). Specifically, Boies et al. teach a third party shipper that associates a real name and address with a received virtual name and address in order to deliver a package (column 2, lines 55-64). Boies et al. also teach shipping labels (figure 2C). Regarding barcodes, the use and function of Postal barcodes, such as POSTNET are old and well known. However, Boies et al. do not specifically recite using websites to associate a real name and address with a virtual name and address. Rhoads teaches a product ordering system that uses scannable codes embedded with website data to obtain more information about a product or service and to relay customer payment information to said website (column 1, lines 40-58; column/line 23/60-24/23). Therefore, it would have been obvious to one of ordinary skill to implement the system of Boies et al. using the scannable codes of Rhoads in order to allow shippers (figure 2C) to more efficiently process payments for providing users with secure mailing services.

10. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Boies et al., U.S. Patent No. 6,006,200 and Rhoads, U.S. Patent No. 6,311,214 as applied to claim 19 and in further view of Pitchenil, U.S. Patent No. 4,796,193.

As per claim 20, Boies et al. teach a method for secure shipping comprising the step of creating an "e-box" is equivalent to creating a user record in the Registry (column 2, lines 11-54). Further, as Boies et al. teach shippers such as USPS, FedEx, or UPS it is inherent that a user is charged for shipping a product based type, weight, or class (column 1, lines 23-34; column 2, lines 4-10). Rhoads teaches a product ordering system that uses scannable codes embedded with website data to obtain more information about a product or service and to relay customer payment information to said website (column 1, lines 40-58; column/line 23/60-24/23). However, neither Boies et al. nor Rhodes explicitly recite scanning a code for charging an account. Pitchenik teaches a postage payment system comprising the scanning of a package in order to determine a user account for charging said account for the provision of mailing services (column 4, lines 39-66; column 6, lines 20-32). Therefore, it would have been obvious to one of ordinary skill to implement the system of Boies et al. using the scannable codes of Rhoads in order to allow shippers ('214, figure 2C) to more efficiently process payments for providing users with secure mailing services ('193, abstract).

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

12. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Calvin Loyd Hewitt II whose telephone number is (703) 308-8057. The Examiner can normally be reached on Monday-Friday from 8:30 AM-5:00 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, James P. Trammell, can be reached at (703) 305-9768.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
c/o Technology Center 2100
Washington, D.C. 20231

or faxed to:

(703) 305-7687 (for formal communications intended for entry and after-final communications),

or:


(703) 746-5532 (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park 5,
2451 Crystal Drive, 7th Floor Receptionist.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113.

Calvin Loyd Hewitt II

May 3, 2004



JAMES P. TRAMMELL
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3200